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OFFICE OF PETITIONS

In re Application of :
Duatartas, Sherrer, Ricks, and :
Steinberg :
Application No. 10/013,084 : DECISION REFUSING STATUS
Filed: 10 December, 2001 : UNDER 37 CFR 1.47(a)
Atty Docket No. ACT-173 (1117-11) :

This is in response to the petition filed under 37 CFR 1.47(a) on 12 August, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 10 December, 2001, without an executed oath or declaration. Accordingly, on 10 January, 2002, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 12 August, 2002, petitioners filed the present petition, along with a five (5) month extension of time and a declaration naming Mindaugas F. Dautartas, David W. Sherrer, Neal

Ricks, and Dan A. Steinberg as joint inventors and signed by all of the joint inventors except Steinberg on behalf of themselves and joint inventor Steinberg.

Petitioners state that joint inventor Steinberg refuses to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). In regards to item (1), petitioners have not provided proof that Steinberg was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

It is also noted that the last page of the declaration as filed is marked "Page 5 of 6". It is unclear whether pages containing additional inventors' names were omitted from the declaration

¹MPEP 409.03(d).

when it was filed in the USPTO. 37 CFR 1.41(a)(1) now defines the inventorship of a non-provisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63.² Therefore, a petition under 37 CFR 1.48 is required if additional inventors are to be added.

The Power of Attorney filed on 12 August, 2002, cannot be accepted because it is signed by fewer than all of the inventors.³ An assignee filing a revocation or power of attorney must establish its right to act in the prosecution of this application.⁴ The assignee must submit evidence of ownership in accordance with 37 CFR 3.73(b). A courtesy copy of this decision will be sent to the address on the petition. All future correspondence, however, will be send solely to the correspondence address of record.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be mailed. The petition fee of \$130.00 has been charged to counsel's deposit account, No. 50-0369, as authorized in the petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

²MPEP 605.

³MPEP 402.10.

⁴See 37 CFR 3.73.

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Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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Office of the Deputy Commissioner
for Patent Examination Policy

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